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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/964,600 | 09/28/2001 | Mihoko Kawahara | 826.1761 | 2413 |
| 21171 | 7590 | 10/04/2005 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | LASTRA, DANIEL | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3622 | | |

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-----------------|-----------------|--|
| Application No. | KAWAHARA ET AL. | |
| 09/964,600 | | |
| Examiner | Art Unit | |
| DANIEL LASTRA | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 July 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-25 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

1. Claims 1-25 have been examined. Application 09/964,600 (PORTABLE TERMINAL DEVICE FOR PROVIDING AND OBTAINING ADVERTISEMENT INFORMATION, ADVERTISEMENT PROVIDING METHOD, ADVERTISEMENT OBTAINING METHOD, ADVERTISEMENT DISTRIBUTING METHOD AND PROGRAM THEREFOR) has a filing date 09/28/2001 and foreign priority 06/04/2001.

Response to Amendment

2. In response to Non Final Rejection filed 03/11/2005, the Applicant filed an Amendment on 07/11/2005, which amended claims 1, 3-17, 23 and added new claim 25.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-24 recite "carried by an advertisement medium" and/or "advertisement medium". The Examiner does not know if said advertisement medium is a user or a device. For purpose of art rejection "carried by an advertisement medium" and/or "advertisement medium" would be interpreted as an advertisement content provider computer. Claims 1 and 3-24 recites "a storage unit storing advertising information about goods a advertisement medium has on or with".

The claims are indefinite because it does not explain the meaning of has on or with. For purpose of art rejection has on or with would be interpreted as stored advertisement in a computer memory. Claims 1-24 also recites "a request to transmit". For purpose of art rejection "request to transmit" would be interpreted as a user communicating with a content provider computer.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Joao (U.S. 2001/0037205).

As per claim 1, Joao teaches:

An advertisement providing method, comprising:

storing in *storage unit* of a portable terminal device *carried by an advertisement medium*, advertising information about goods the advertisement medium has on or with (see paragraphs 18-20; 87-88); and transmitting the advertising information *stored in the storage unit* ("content provider computer" paragraph 18) by a wireless signal upon

receipt of a request to transmit advertising information *from another portable terminal device* (see paragraph 18-20; 86-87; "user computer"; paragraph 17).

As per claim 2, Joao teaches:

The method according to claim 1, wherein said advertising information includes information specifying a position in a network of a server which provides advertising information about goods (see paragraph 12).

As per claim 3, Joao teaches:

A portable terminal device, comprising:

a wireless signal transmission and reception unit (see paragraph 86);

a storage unit storing advertising information about goods a advertisement medium has on or with (see paragraphs 77); and

a control unit instructing said wireless signal transmission and reception unit to transmit advertising information stored in said storage unit (see content provider computer) when a request to transmit advertising information is received *from another portable terminal device* (see paragraphs 18-20; "user computer").

As per claim 4, Joao teaches:

An advertisement obtaining method, comprising:

requesting a portable terminal device ("content provider computer") *carried by* an advertisement medium to transmit advertising information *to another portable terminal device* (see paragraphs 18-20" user computer");

receiving *by said other portable terminal device* ("user computer") advertising information about goods the advertisement medium has on or with transmitted from said

portable terminal device *carried by* the advertisement medium (see paragraphs (see paragraphs 18-20; "content provider computer"); and

displaying the received advertising information on a *display unit of said other* portable terminal device (see paragraphs 18-20; 87).

As per claim 5, Joao teaches:

An advertisement obtaining method, *according to claim 4, wherein:*

Said other portable terminal device requests the portable terminal device of the advertisement medium for a plurality of times to transmit advertising information (see paragraphs 18-20) under a condition that the advertisement medium carrying the portable terminal device is positioned within a receivable area of the wireless signal (see paragraph 87). It is inherent that a user computer and a content provider computer have to be positioned within a receivable area of the wireless signal to be able to wirelessly communicate between each other (see paragraphs 85-87);

receiving *user-specific information of the advertisement medium* transmitted from the portable terminal device of the advertisement medium *by said other terminal device for a plurality of times* (see paragraphs 98-100), and

determining the identity of the advertisement medium using the received user-specific information (see paragraphs 98-100).

As per claim 6, Joao teaches:

The method according to claim 4, *further comprising:*

receiving user-specified information of a plurality of advertisement mediums (see paragraphs 98-100) and

requesting to view advertising information for specifying received user-specified information and a profile of the advertisement medium having goods on or with (see paragraph 132).

As per claim 7, Joao teaches:

A portable terminal device, comprising:

wireless signal transmission and reception an advertisement request unit requesting *another* portable terminal device of an advertisement medium to transmit advertising information (see paragraphs 18-20); and

a control unit instructing the wireless signal transmission and reception unit to receive advertising information, transmitted from the portable terminal device of an advertisement medium, about goods the advertisement medium has on or with, and displaying the received advertising information (see paragraphs 18-20).

As per claim 8, Joao teaches:

A data signal for a computer implemented in a form of a carrier signal constituting a program for realizing the functions of:

storing advertising information about goods an advertisement medium has on or with in a *storage unit of a portable terminal device carried by the advertisement medium* (see paragraphs 18-20; “content provider computer”); and

transmitting stored advertising information by a wireless signal when a request to transmit advertising information is received *from another portable terminal device* (see paragraph 18-20; 86; user computer).

As per claim 9, Joao teaches:

A computer-readable storage medium storing a program for realizing the functions of:

storing advertising information about goods an advertisement medium has on or with in a *storage unit of a portable terminal device carried by the advertisement medium* (see paragraphs 18-20; “content provider computer”); and

transmitting stored advertising information by a wireless signal when a request to transmit advertising information is received *from another portable terminal device* (see paragraphs 18-20; 86; “user computer”).

As per claim 10, Joao teaches:

A data signal for a computer implemented in a form of a carrier signal constituting a program for realizing the functions of:

requesting a portable terminal device *carried by* an advertisement medium to transmit advertising information *from another portable terminal device* (see paragraphs 18-20; “user computer”); and

receiving *by said other portable terminal device* advertising information about goods the advertisement medium has on or with transmitted from said portable terminal device *carried by the advertisement medium*, and displaying the received advertising information on a *display unit of said other portable terminal device* (see paragraphs 18-20; “user computer”).

As per claim 11, Joao teaches:

A computer-readable storage medium storing a program for realizing the functions of:

requesting a portable terminal device *carried by* an advertisement medium to transmit advertising information *from another portable terminal device* (see paragraphs 18-20; “user computer”); and

receiving *by said other portable terminal device* advertising information about goods the advertisement medium has on or with transmitted from said portable terminal device *carried by the* advertisement medium, and displaying the received advertising information on a *display unit of said other portable terminal device* (see paragraphs 18-20).

As per claim 12, Joao teaches:

The storage medium according to claim 11, wherein said portable terminal device *carried by an advertisement medium* has the functions of performing wireless communications with a wireless base station in a portable telephone network, and performing wireless communications with *other* portable terminal device (see paragraph 86).

As per claim 13, Joao teaches:

An advertisement distributing method, comprising:
storing plural pieces of advertising information (see paragraph 18);
receiving a user entry of an advertisement medium (see paragraphs 18-20);
distributing advertising information about goods to a portable terminal device of an advertisement medium who has gained user entry (see paragraphs 18-20); and
retrieving a corresponding advertisement and distributing the advertisement to *another* portable terminal device (see “user computer”) of a consumer when a request

to view an advertisement is received according to advertising information transmitted from the portable terminal device of an advertisement medium to the portable terminal device of a consumer (see paragraphs 18-20).

As per claim 14, Joao teaches:

A computer-executable program for realizing the functions of:
storing plural pieces of advertising information (see paragraph 18);
receiving a user entry of an advertisement medium (see paragraphs 18-20);
distributing advertising information about goods to a portable terminal device of an advertisement medium who has gained user entry (see paragraphs 18-20); and
retrieving a corresponding advertisement and distributing the advertisement to *another* portable terminal device of a consumer (see "user computer") when a request to view the advertisement is received according to advertising information transmitted from the portable terminal device of an advertisement medium to the portable terminal device of the consumer (see paragraphs 18-20).

As per claim 15, Joao teaches:

An advertisement distributing method, comprising:
storing plural pieces of advertising information (see paragraphs 18-20);
distributing advertising information about goods at a request of an advertisement medium to a portable terminal device (see paragraphs 18-20); and
giving an advertising reward to the advertisement medium who has provided the advertising information when a consumer views an advertisement or buys the goods after receiving the advertising information and according to the advertising information

transmitted from the portable terminal device of the advertisement medium to *another* portable terminal device of the consumer (see paragraphs 18-20; "user computer").

As per claim 16, Joao teaches:

An advertisement distributing method, comprising:

storing plural pieces of advertising information (see paragraphs 18-20); and

receiving a user entry of an advertisement medium (see paragraphs 18-20),

distributing advertising information about goods to a portable terminal device of the advertisement medium who has gained user entry (see paragraphs 18-20), and

realizing the function of requesting transmission of advertising information or transmitting advertising information between a portable terminal device of the advertisement medium and *another* portable terminal device of a consumer (see paragraphs 18-20; 87-88; "user computer").

As per claim 17, Joao teaches:

A advertisement distributing method, comprising:

storing plural pieces of advertising information (see paragraph 18);

receiving a user entry of an advertisement medium (see paragraphs 18-20);

distributing advertising information about goods to a portable terminal device of the advertisement medium who has gained user entry (see paragraphs 18-20); and

retrieving a corresponding advertisement and distributing the advertisement to *another* portable terminal device of a consumer ("user computer") when a request to view the advertisement is issued from the portable terminal device of the consumer with

the advertising information and user-specified information for designation of the advertisement medium specified (see paragraphs 18-20).

As per claim 18, Joao teaches:

An advertisement distributing method, comprising:

storing plural pieces of advertising information (see paragraph 18);

receiving a user entry of an advertisement medium (see paragraphs 18-20);

retrieving advertising information of corresponding goods when a request to view advertising information is received from a portable terminal device of a consumer containing user specified information about an advertisement medium and a retrieval condition of goods (see paragraphs 18-20); and

distributing the advertising information obtained by the retrieval to the portable terminal device of the consumer (see paragraphs 18-20).

As per claim 19, Joao teaches:

The method according to claim 18, wherein said user information comprises user-specified information, information designating whether or not an advertisement can be distributed, a term of distribution, and information designating access destination for advertising information (see paragraph 24).

As per claim 20, Joao teaches:

An advertisement distributing method, comprising:

storing plural pieces of advertising information (see paragraph 18);

accepting user entry of an advertisement medium (see paragraph 18);

storing user-specified information and a profile about the advertisement medium who has gained the user entry, and advertisement specified information for designation of advertising information about goods the advertisement medium has on or with (see paragraph 18-20); and

retrieving the advertisement medium having a matching or similar profile to a profile specified by a consumer from information about the entered advertisement medium and distributing advertising information of goods the advertisement medium has on or with to a portable terminal device of the consumer when a request to view an advertisement with the user specified information and the profile of the advertisement medium specified by the consumer is received from the portable terminal device of the consumer (see paragraphs 18-20; 71-73).

As per claim 21, Joao teaches:

The method according to claim 20, wherein a profile matching or similar to the profile of an advertisement medium specified by the consumer is retrieved (see paragraph 132);

advertisement specified information stored as associated with the advertisement medium having matching or similar profile specified by the consumer is obtained (see paragraph 132); and

advertising information specified by the obtained advertisement specified information is retrieved, and the advertising information obtained by the retrieval is distributed to the portable terminal device of the consumer (see paragraph 132).

As per claim 22, Joao teaches:

A advertisement distributing method, 15 comprising:

storing plural pieces of advertising information (see paragraph 18);

accepting a user entry of an advertisement medium and a consumer, and storing user-specified information about the advertisement medium who has gained the user entry, goods specified information designating goods the advertisement medium has on or with, user-specified information about the consumer who has gained the user entry, and a profile of the consumer (see paragraphs 18-20; 132);

retrieving the goods specified information designating the goods the advertisement medium has on or with corresponding to the user-specified information about the advertisement medium, and the profile of the consumer corresponding to the user specified information about the consumer (see paragraphs 18-20);

obtaining advertising information matching the profile of the consumer based on the retrieval result (see paragraph 132); and

distributing the obtained advertising information to a portable terminal device of a consumer (see paragraph 132).

As per claim 23, Joao teaches:

An advertisement distribution device, 15 comprising:

an advertisement storage unit storing plural pieces of advertising information (see paragraph 18);

an entry unit accepting a user entry of an advertisement medium (see paragraphs 18-20);

an advertisement distribution unit distributing advertising information about goods to a portable terminal device of an advertisement medium who has gained the user entry (see paragraphs 18-20); and

a retrieval/distribution unit retrieving a corresponding advertising information from said advertisement storage unit, and distributing the advertising information to *another* portable terminal device of a consumer (see paragraphs 18-20).

As per claim 24, Joao teaches:

An advertisement distribution device, comprising:

an advertisement storage unit storing plural pieces of advertising information (see paragraphs 18-20);

an entry unit accepting a user entry of an to advertisement medium (see paragraphs 18-20);

a user information storage unit storing a profile and user-specified information about the advertisement medium who has gained the user entry (see paragraphs 18-20),

and advertisement specified information designating advertising information about goods the advertisement medium has on or with (see paragraphs 18-20); and

retrieving the advertisement medium having a matching or similar profile to a profile specified by a consumer from said user information storage unit and distributing advertising information of goods the advertisement medium has on or with to a portable terminal device of a consumer when a request to view an advertisement with user specified information and the profile of the advertisement medium specified by the

consumer is received from the portable terminal device of the consumer (see paragraph 132).

As per claim 25, Joao teaches:

A system comprising:

a first portable device allowing an advertiser to enter and store advertising information therein (see paragraphs 17-18; "content provider computer") and allowing the advertiser to wirelessly transmit the advertising information responsive to a request (see paragraphs 85-87) ; and

a second portable device (see paragraph 17-18; "user computer") allowing a consumer to wirelessly request the advertising information stored in the first portable device and displaying the advertising information wirelessly received from the first portable device (see paragraphs 85-87, 97).

Response to Arguments

5. Applicant's arguments filed 07/11/05 have been fully considered but they are not persuasive. The Applicant argues that Joao does not teach two portable devices. The Examiner answers that Joao teaches in paragraph 88 that the content provider computer can also be any suitable or appropriate computer and/or communication device and paragraph 86 that the user computer and content provider computer can wirelessly communicate bi-directional between each other. Therefore, it is inherent that a content provider computer can be a portable computer that would communicate with said user computer (i.e. another portable computer), similar to the Applicant's claimed invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The Examiner's Right fax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL
Daniel Lastra
September 28, 2005

Yehdega Retta
RETTA YEHDEGA
PRIMARY EXAMINER